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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,444	10/22/2003	Paul E. Denney	LOMASR.026A	8101

20995 7590 03/29/2007
KNOBBE MARTENS OLSON & BEAR LLP
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IRVINE, CA 92614

EXAMINER

EVANS, FANNIE L

ART UNIT PAPER NUMBER

2877

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/29/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/29/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary

Application No.

10/691,444

Applicant(s)

DENNEY ET AL.

Examiner

F. L. Evans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 and 13-16 is/are allowed.
- 6) ☒ Claim(s) 12, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>110606</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Information Disclosure Statement

The prior art cited in the information disclosure statement filed on November 6, 2006 has been considered.

Claim Rejections - 35 USC § 101

35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12, 17 and 18 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed to a judicial exception, an abstract idea; as such, pursuant to the Interim Guidelines on Patent Eligible Subject Matter (MPEP 2106), the claims must have either physical transformation and/or a useful, concrete and tangible result. The claims fail to include transformation from one physical state to another. Although, the claims appear useful and concrete, there does not appear to be a tangible result claimed. Merely analyzing at least a portion of the spectrum (lines 9 and 10 of independent claim 12) would not appear to be sufficient to constitute a tangible result, since the outcome of the analyzing step has not been used in a disclosed practical application nor made available in such a manner that its usefulness in a disclosed practical application can be realized. As such, the subject matter of the claims is not patent eligible.

Attention is directed to section IV. of MPEP 2106, "DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. SEC. 101." In part C.2.(2), "Practical Application That Produces a Useful, Concrete, and Tangible Result", the second and third sentences state 'If USPTO personnel determine that the claim does not entail the transformation of an article, then USPTO personnel shall review the claim to determine if it produces a useful, tangible, and concrete

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result. In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is "useful, tangible, and concrete."

The dependent claims do not appear to add any real world application required by MPEP 2106.

Response to Arguments

Applicant's arguments with respect to the rejection of claims 11, 13, 15 and 16 under 35 U.S.C. § 102(b) have been fully considered and are persuasive. The rejection of the claims has been withdrawn.

Applicant's arguments with respect to the rejection of independent claims 1 and 11 under 35 U.S.C. § 103(a) have been fully considered and are persuasive. The rejection of the claims has been withdrawn.

Applicant's arguments with respect to the rejection of claims 12, 17 and 18 under 35 U.S.C. § 101 have been fully considered but they are not persuasive.

Contrary to applicant's assertion in the first paragraph on page 6 of the response filed on February 8, 2007, the invention set forth in independent claim 12 does not set forth a tangible result. The final result of the method of claim 16 is the step of analyzing at least a portion of the spectrum for indications of the exposed embedded object. The analyzing step is merely data manipulation performed by a microprocessor. See lines 4-6 in paragraph [0140] in the specification. The analyzing step is not a tangible (real world) result. The claim fails to set forth a step of using the result of the analysis in the real world to achieve a tangible result.

Allowable Subject Matter

Claims 1-11 and 13-16 are allowed over the prior art of record.

As to independent claim 1, the prior art of record, taken alone or in combination, fails to disclose or render obvious the claimed invention for the reasons set forth in the first and second paragraphs on page 10 and the paragraph bridging pages 13 and 14 of applicant's response

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As to independent claim 8, the prior art of record, taken alone or in combination, fails to disclose or render obvious the claimed invention for the reasons set forth on page 5 of the Office action mailed on February 8, 2006.

As to independent claim 11, the prior art of record, taken alone or in combination, fails to disclose or render obvious the claimed invention for the reasons set forth in the first paragraph on page 8 of applicant's response.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Fax/Telephone Numbers

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner whose telephone number is (571) 272-2414.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on (571) 272-2800 ext 77. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer

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Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



F. L. EVANS
PRIMARY EXAMINER
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March 22, 2007